

## **REMARKS**

### **Status of the Claims**

Upon entry of the instant amendment, claims 1 and 5-17 remain pending in the above-identified application, with claims 1 and 5-10 standing ready for further action on the merits, and remaining claims 11-17 being withdrawn from consideration based on an earlier restriction requirement of the Examiner. Claims 2-4 have been cancelled without prejudice or disclaimer of the subject matter contained therein.

Claim 1 and 5-17 have been amended. The instant amendment made herein to the claims does not incorporate new matter into the application as originally filed. For example, claim 1 is amended based on previous claim 2, the disclosures at page 2, line 34 of the specification, and figures of the present application. Also, claims 5-17 are amended in view of formalities so as to further clarify the present invention.

As such entry of the instant amendment and favorable action on the merits are earnestly solicited.

### **Title of the Invention**

The specification is objected to because of the title of the invention. The objection is respectively traversed.

While not conceding to the Examiner's objection, but to merely advance prosecution, the title of the invention is amended herein. In view of the amendment to the specification, the objection should be overcome. Reconsideration and withdrawal thereof are respectfully requested.

**Claim Objections and Rejection Under 35 U.S.C. § 112, 2nd Paragraph**

Claim 3 is objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Further, claim 3 is rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The objections and rejection are respectfully traversed.

In this Amendment, claim 3 is cancelled. Accordingly, withdrawal of the objection and rejections are respectfully requested.

**Claim Rejections Under 35 U.S.C. §§ 102 & 103**

Claims 1-7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Uchimura et al. JP '395 (JP 2003-013-013395 A).

Further, claims 8-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Uchimura et al. JP '395.

Finally, claim 1-10 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Brownfield US '493 (US 6,306,493).

These rejections are respectfully traversed. Reconsideration and withdrawal of the rejections are respectfully requested based on the following considerations.

**Distinctions and Nonobviousness over the Cited References and the Combination thereof**

In view of the current amendments to the claims, the present invention is further defined over the cited references.

In Uchimura et al. JP '395, a marked multilayer paper is produced by providing a paper sheet with laser-made perforations and using this laser-marked sheet as a prefabricated middle layer in a formation process on an endless papermaking screen, so as to form outer fibrous layers from freshly supplied papermaking pulp. The marks are thus buried within the triple-layer web of paper that is being produced. This is quite different from the claimed invention. The present invention is not a formation process on a screen. In the claimed invention, the layers are moving webs that are brought together, and laser-marking is carried out in a production line so as to make marks on a web in motion.

Furthermore, in the claimed invention, the marks are darker oxidized areas on the surface of the web, not perforations as disclosed in Uchimura et al. JP '395. The marks in the claimed invention are realized as spots which are darker than their surroundings, whereas in Uchimura et al. JP '395, the perforated marks appear as lighter portions than the surroundings. A triple-layer structure is employed in Uchimura et al. JP '395 in order to shield the marks from both sides, whereas in the claimed invention, a double-layer structure can be employed for covering the surface marks (although a triple-layer embodiment may be employed in the present invention for other reasons, not just for protecting the embedded marks). Therefore, the claimed invention is distinguishable from Uchimura et al. JP '395.

Further, Brownfield US '493 fails to disclose or suggest the claimed features. For example, Brownfield US '493 fails to disclose or suggest embedding marks in a layered webs so as to cover identification marks. Brownfield US '493 merely discloses ordinary paper coating techniques, where the coating step is conducted prior to the laser marking step. Thus, Brownfield US '493 fails to disclose or suggest that i) marks are made on a moving web, and then ii) the marks are covered or buried by a second layer. Incidentally, the term "marked paper"

in column 5, line 27 of Brownfield US '493 should be a typographical error and read "markable paper" since the paper is subject to further processing without affecting its markability in Brownfield US '493. It is proper interpretation to one skilled in the art that what is disclosed in Brownfield US '493 is preservation of the markability of a "markable paper," not "marked paper".

Therefore, the present invention is not anticipated by the cited references since each of the cited references fails to disclose or suggest the claimed features. ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Further, there is no rationale and/or reasonable expectation of success based on the cited references or the combination thereof, by which one skilled in the art could arrive at the present invention as claimed, since the cited references fail to disclose or suggest each of the instantly claimed features, as explained above. Thus, it is submitted that the present invention is not obvious over the cited references or the combination thereof.

Based on the foregoing considerations, Applicants respectfully request that the Examiner withdraw the rejection.

**Conclusion**

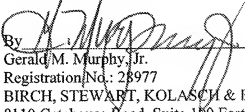
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims is allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Toyohiko Konno, Reg. No. L0053 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

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